Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAN J. RIGNEY

Appeal No. 1999-0969
Application No. 08/790,501

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judges, GONZALES, and LAZARUS, Administrative Patent Judges.

LAZARUS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 6-9 and 13. Claims 2, 4, 5, 10-12 and 14-15, the other claims in this application, have been indicated as allowable, subject to being rewritten in independent form (answer, page 3).

We affirm.

BACKGROUND

The appellant's invention relates to an artificial bait with breakaway segments for adjusting the drop rate in water (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Rigney 5,438,790 Aug. 8, 1995

Claims 1, 3, 6-9 and 13 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Rigney.[1]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed November 18, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 10, filed October 29, 1998) and reply brief (Paper No. 13, filed January 19, 1999) for the appellant's arguments thereagainst.

[1] The rejection of claims 2, 4, 5, 10-12 and 14-15 has been withdrawn by the

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The 35 U.S.C. § 102(b) rejection of claims 1 and 3 as being clearly anticipated by Rigney.

We will sustain the examiner's 35 U.S.C. § 102(b) rejection of claims 1 and 3.

Claim 1 recites:

1. An artificial bait comprising:

a body shaped to simulate a natural bait and having a predetermined base drop rate when immersed in water with a threshold weight attached thereto; and

means on said body for delineating a breakaway segment from a main segment thereof, said main segment of said body having a predetermined drop rate faster than said predetermined base drop rate when immersed in water with the

examiner (answer, page 3).

threshold weight attached thereto and said breakaway segment removed therefrom.

At the outset we note that Rigney discloses an artificial bait 30 shaped to simulate a natural bait (crawdad (fig. 1) or a worm (fig. 2)) "which, in combination with a hook, sinks at relatively low rates of descent" (col. 1, lines 57-58). Various predetermined descent (or drop) rates are shown in the table in column 4. Appellant and the examiner disagree only on whether Rigney teaches the "means" portion of appellant's claim 1.

The examiner's rejection states "Rigney discloses a body shaped to simulate a natural bait (figures 1-3) and a means on said body for delineating a breakaway segment (31, figure 1)" (final rejection, page 1). In dismissing appellant's prior argument, it is explained that "the limitations in the claims directed to the drop rates of the bait before and after the segments are removed are given very little patentable weight... these limitations are use limitations and fail to further defined (*sic*) the structure of the artificial bait" (final rejection, page 3).

An express teaching or even an express disclosure is not required to establish anticipation as appellant seems to

argue. Instead, to anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. See In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Although we disagree with the examiner's statement regarding the means limitations, we nevertheless sustain the rejection for the reasons that follow.

Appellant correctly notes that "functional language can be used to define a structural element of (*sic*) claim" (reply brief, page 2). The portion of the "means" clause, "said main segment of said body having a predetermined drop rate faster than said predetermined base drop rate when immersed in water with the threshold weight attached thereto and said breakaway segment removed therefrom" is described as "[t]he pertinent language of claim 1" and it is asserted "[t]his is a structural limitation claimed by functional language" (id.).

We find that all of the features of claim 1, including the "means" limitation, are disclosed, expressly or inherently, by Rigney. The "means" limitation of claim 1, is met by the contour of the artificial bait shown in Rigney's drawings. Appellant's disclosure recites several ways to

delineate portions of the bait for removal. "[T]he delineation may be accomplished, for example, by... distinct changes in contour of the bait material, such as by the junction point 27 of the leg 29 with the main segment of the body 11" (specification, page 6). Figure 1 of Rigney shows a main segment of a crawdad body with legs joined to the body at junction points. The contour of the junction points in Rigney are virtually the same as the contour of the junction points in appellant's drawings. To the extent that appellant's legs can be broken away from the body, the legs in Rigney likewise are inherently capable of being broken away in a similar fashion, which is all that is required. Thus, appellant's subject matter of claim 1 is satisfied by Rigney.

It follows that we will sustain the examiner's rejection of claim 1, and also of dependent claim 3, which specifies the contour as the delineating feature.

The 35 U.S.C. § 102(b) rejection of claims 6-9 and 13 as being clearly anticipated by Rigney.

We will also sustain the examiner's 35 U.S.C. § 102(b) rejection of claims 6-9 and 13.

Appellant's grouping of claim 6 separate from claim 1 urges "Claim 6 further requires: (1) a plurality of breakaway segments; and (2) volumetric relationship of the breakaway segments to the main segment; (3) the predetermined drop rates corresponding to the number (or total volume) of segments broken away" and "[t]his plurality of volumetrically related segments is nowhere taught or suggested in Rigney '790" (brief, page 9).

As noted above, Figure 1 of Rigney shows a main segment of a crawdad body with legs joined to the body at junction points. We find that the shape of the crawdad body in Rigney is identical, or virtually identical, to the shape in appellant's application.

We further find that the volumetric relationship of the breakaway segments to the main segment and the predetermined drop rates corresponding to the number (or total volume) of segments broken away are expressly described, or inherent, in the disclosure of Rigney. It is sufficient for purposes of anticipation that the reference inherently discloses each element (or elements). See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053.

Rigney discloses "[t]he hook or jig has an average density greater than the average density of water while the artificial bait has an average density less than the average density of water" and "the volume of the bait is proportioned to the volume of the hook so that their average density taken together slightly exceeds the average density of the water so that the hook and the body together sink relatively slowly in the water" (col. 2, lines 2-13). Upon removal of one or more segments, such as leg segments, from Rigney's crawdad (fig. 1), the predetermined drop rate (described in the table in column 4) of the initial body will inherently increase because removal of a segment results in a less buoyant, artificial bait material. Accordingly, appellant's arguments do not establish any difference between Rigney and claim 6 on appeal. It follows that we will sustain the examiner's rejection of claim 6 inasmuch as all of the limitations are either expressly, or inherently, disclosed in Rigney.

We also find that the limitations of claims 7-9, which further modify claim 6 by specifying at least two breakaway segments extending "serially" (claim 7) and "independently" (claim 8) from said main segment with the main and breakaway

segments simulating natural bait and appendages (claim 9), respectively, are shown by the features of Rigney's crawdad (Figure 1). For the reasons earlier expressed with respect to claim 3, we find the contour delineating feature of claim 13 to be disclosed by Rigney.

Based on the foregoing analysis of the Rigney patent, we are satisfied that this reference meets all of the limitations in claims 1, 3, 6-9 and 13.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3, 6-9 and 13 under 35 U.S.C. § 102(b) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

HARRISON E. McCANDLISH Senior Administrative Patent Judge	)
JOHN F. GONZALES Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
RICHARD B. LAZARUS Administrative Patent Judge	)

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APPEAL NO. 1999-0969 - JUDGE LAZARUS
APPLICATION NO. 08/790,501

APJ LAZARUS

APJ McCANDLISH

APJ GONZALES

DECISION: **AFFIRMED**

Prepared By: RBL

DRAFT TYPED: 26 Jun 01

FINAL TYPED: